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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,016	01/23/2001	Stanley B. Miller III	500	9290

7590

06/26/2002

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EXAMINER

TRAN, SUSAN T

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,016

Applicant(s)

Miller III et al.

Examiner

Susan Tran

Art Unit

1615



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 11, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

Art Unit: 1615

DETAILED ACTION

Receipt is acknowledged of applicant's Declaration and Fee filed 03/26/01, Information Disclosure Statement filed 07/09/01, and Amendment A filed 04/11/02.

Election/Restriction

1. Claims 13-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction requirement in Paper No. 6.

Applicant's election with traverse of Group I, claims 1-6, drawn to an acid-gas absorbing tablet, classified in class 424, subclass 464 in Paper No.6, filed 04/11/02 is acknowledged.

The restriction requirement of Groups II and IV is withdrawn, claims 7-12 and 19-27 are rejoined and fully examined for patentability.

Applicant's arguments filed 04/11/02 have been fully considered but they are not persuasive.

Requirement for restriction practice are set forth in MPEP§803.

There are two criteria for a proper requirement for restriction between patentable distinct inventions:

1. The inventions must be distinct as claimed (see MPEP§806.05-806.05(I)); and
2. There must be a serious burden on the examiner if restriction is not required (see MPEP§803.02, 806.04(a)-(j), 808.01(a) and 808.02).

Art Unit: 1615

The traversal is on the ground that group III invention is a device for using the product, and that the device and the product, or the method have the same limitation of “at least one adsorbent, a binder, and at least one basic salt”, and therefore would not be a serious burden on the examiner. This is not found persuasive because:

A serious burden on the examiner is shown according to the criteria of MPEP§808.02, where one of the following must be supported by appropriate explanation:

1. Separate classification thereof;

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

2. A separate status in the art when they are classifiable together; and
3. A different field of search.

In the restriction requirement of 03/04/02, the examiner set forth separate classification for the four inventions to which claims were presented. Classification of the device claims is in class 118. Classification of the process and product claims is in class 424. Applicant has not alleged that either device or process or product claims were improperly classified. Nor has applicant alleged that the classifications set forth are not “separate classifications.” Thus, requirements 1 and 3 of MPEP§803 are met. For these reasons set forth above, the restriction requirement is proper.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1615

Claim Rejections - 35 U.S.C. § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is indefinite in the use of the phrase "the binder polyvinylpyrrolidinone". The phrase is unclear as to the phrasing of the words. It is suggested to amend to "polyvinylpyrrolidinone as the binder".

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5, 7, 8, 10, and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by Tuma et al. US 6,168,651.

Tuma teaches shaped adsorbent articles useful in electronic device (see abstract). The article comprising mixtures of adsorbent materials includes activated carbon, silica gel, calcium

Art Unit: 1615

carbonate, potassium carbonate, potassium permanganate, calcium sulfate, and sodium carbonate; and binder includes microcrystalline cellulose, starch, sodium silicate, and polyvinylpyrrolidone (columns 5-6). The adsorbent article can be formed using compression molding or tablet-forming method (id, column 9, lines 47-62).

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al.

Tuma is relied upon for the reason stated above. In the case that the applicant can overcome the above 102(a) rejection, the examiner relies on the 103(a) rejection. Although Tuma teaches mixtures of adsorbent materials including silica gel, activated carbon, and numbers of organic salts, Tuma does not teach a second salt primarily associated with the binder recited in applicant's claim 9. Nonetheless, Tuma teaches the binder and the adsorbent are mixed together (column 6). Hence, it would have been obvious for one of ordinary skill in the art to modify Tuma's adsorbent article with the expectation of at least similar result, because Tuma also

Art Unit: 1615

teaches a shaped article useful in electronic device to adsorb acid gas. Absent of showing unexpected result, it is the position of the examiner that no criticality is seen in a particular second basic salt mixed with the binder.

5. Claims 6, 12, and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al., and Osborne et al. US 4,855,276.

Tuma is relied upon for the reasons stated above. The reference is silent as to the teaching of sodium or potassium bicarbonate.

Osborne teaches adsorbent composition comprising activated carbon powder, activated alumina, water, and sodium bicarbonate (columns 5-6). Thus, it would have been prima facie obvious for one of ordinary skill in the art to prepare Tuma's adsorbent article using basic salts taught by Osborne, because the references teach the advantageous results in the use of basic salts in adsorbent composition. The expected result would be an adsorbent article in a variety of shapes useful to be placed in smaller spaces, such as disk drives.

The examiner notes that the cited references do not teach the particular second salt, e.g., potassium bicarbonate. However, it would have been obvious for the skilled artisan to, by routine experimentation determine a suitable salt to obtain a desirable adsorption of the contaminants, such as acid gas. The reason for this modification is because the references teach the advantageous results in the use of basic salts in adsorbent composition, e.g., sodium carbonate, potassium carbonate, and sodium bicarbonate.

Art Unit: 1615

Pertinent Arts

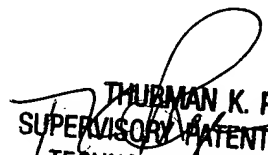
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Inoue et al., Dahlgren et al., and Moskovitz et al. are cited as being of interest for the teaching of adsorbent composition.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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